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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/673,567	10/18/2000	Yoshihiko Hibino	001248	8750

7590

05/20/2003

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EXAMINER

SCHWARTZ, PAMELA R

ART UNIT

PAPER NUMBER

1774

DATE MAILED: 05/20/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application N .

09/673,567

Applicant(s)

HIBINO ET AL.

Examiner

Pamela R. Schwartz

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>2</u> . | 6) <input type="checkbox"/> Other: |

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1. Claims 1-5 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. This rejection is repeated for reasons of record in the last office action and for reasons given below. Applicants argue that even though they have not obtained an English version of JIS P-8148 that predates the filing of the instant application, there is no requirement that the Standard be available in English. Under 35 CFR 1.52 (b)(1)(ii), specifications are required to be in English or accompanied by a translation. Since applicants are in essence incorporating this Standard into the specification, it is part of the specification and must have been available in the English language at the time applicants filed their application. Therefore, this ground of rejection is still considered to be appropriate. If applicants can cite an authority which states that it is permissible to incorporate by reference foreign language documents, this ground of rejection will have been overcome.

With respect to HYMACS SC600-G2, it is unclear how partial translations of safety data sheets prove that the material disclosed therein was available in the United States at the time of the invention and that one of ordinary skill in the art would have been able to make and use the invention. If applicants can identify how one of ordinary skill in the art would have been able to obtain this material without knowing how to read or speak Japanese, they may be able to overcome this rejection.

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2. Claims 1-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Koide et al. (5,756,151) in view of Yasuda et al. (4,944,988) and Koji et al. (EP 0745,488) for reasons of record and for reasons given below.

Applicant's arguments filed February 28, 2003 have been fully considered but they are not persuasive. Rejection based upon the second paragraph of 35 U.S.C. 112 is withdrawn. Applicants first argue that the declaration demonstrates unexpected and surprising results obtained through use of a cationic polymer fixing agent when compared to Koide et al. which does not include such an agent. This is unpersuasive, first because the rejection is based upon a combination of references, and second, because one of ordinary skill in the art would have expected at least some of the improvements obtained through use of such an agent. For example, since the purpose of such agents is to fix dye or pigment in the recording layer, it is natural that the fixed dye or pigment will be less likely to move in the medium, consequently leading to an increase in image density, water resistance and image reproducibility.

Yasuda et al. states that the "binder exhibits a remarkably enhanced membrane strength and bonding strength to pigment particles" (see col. 7, lines 23-25). Yasuda et al. also disclose the use of cationic polymers as water-proofing agents (col. 9, lines 36-40). Consequently, the results obtainable through inclusion of such materials are well known. Since there are many reasons why it would have been desirable to include these materials in the medium of the primary reference, it would have been obvious to one of ordinary skill in the art to do so. Applicants also argue that a large group of other properties are inherently enhanced with a cationic polymer fixing agent is added. These

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properties were all known properties in the art and it would have been obvious to one of ordinary skill in the art to optimize as demonstrated by the primary reference. It is unclear from applicants' argument how the primary reference actually teaches away from the instantly claimed invention.

Applicants also argue that the spectral reflectance of Koide et al. is not comparable to the ISO brightness instantly claimed because it is measure over light in a wide wavelength as opposed to a narrow wavelength in the vicinity of 460nm. According to Koide et al., the spectral reflectance within their range of 440 nm to 640 nm remains relatively constant, i.e. within 5% or less, at a level of at least 85%. Once again, it is unclear how this teaches away from the instant invention.

Finally applicants state that there is no motivation to combine the teachings of the references. The motivations for combining each of the references has been set forth already, for Yasuda et al., in order to obtain the improvements related to the use of a cationic polymer disclosed therein and discussed above. The motivation to limit the support as taught by Koji et al. is to increase water resistance and improve ink absorption.

3. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the

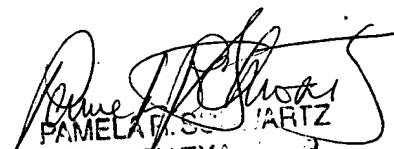
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shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Pamela R. Schwartz whose telephone number is 703-308-2424. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia Kelly, can be reached on (703) 308-0449. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9310.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

PRSchwartz
May 17, 2003



PAMELA R. SCHWARTZ
PRIMARY EXAMINER